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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,642	06/11/2001	John Albert Hockman	01-016	3119

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1 Highland Avenue
Bethlehem, PA 18017

EXAMINER

HOFFMANN, JOHN M

ART UNIT PAPER NUMBER

1731

DATE MAILED: 11/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,642

Applicant(s)

HOCKMAN, JOHN ALBERT

Examiner

John Hoffmann

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3 October 2003 has been entered.

Information Disclosure Statement

It is noted that although the PTO-1449 (as initialed by Exr. Colaanni) refer to various foreign patents, the present examiner could only locate translations of the documents, and not the patents themselves. The action is based on the translations and not the foreign patents themselves.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 4-9 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support for a conclusion that the z is a subscript for the "O".

It is clear on page 5, lines 5-9, that there is an error, because there is no "z" in the formula - even though there is a "z" mentioned on line 8. However, it is not clear what the error is. An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of the error in the specification, but also recognize the appropriate correction. In re Oda, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971). There is no reason to believe that one of ordinary skill would recognize what the appropriate correction would be.

Page 6 of the specification gives a specific glass composition that lists 3 additional ingredients (alumina, iron oxide and sodium oxide) that take the silicate outside the scope of amended claim 1. It is quite possible that the error in the formula is that there are other terms missing which have the "z" and which permit the inclusion of one or more additional ingredients such as alumina, iron oxide and sodium oxide.

Further: page 5 of the specification refers to US patent 6211103 which indicates that "z" is the subscript for Si and the subscript for O is "x+y+2z". Perhaps this is what the correction could be.

Or even: US Patent 6287378 (of which the present inventor is a co-inventor) describes (col. 6, line 19) magnesium calcium silicates with "X" water molecules as well as O and OH species with subscripts (D) and (E). Perhaps one of these speak to what the actual correction could be.

As indicated above, it is clear one would recognize the existence of the error, but Applicant has failed to show that one skilled would recognize the appropriate correction

- The state of prior art indicates that there are various possible corrections. Thus it would be impossible to ascertain what the appropriate correction would be.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 4-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 3: there is no antecedent basis for "the calcium magnesium silicate". There is only prior mention of a "calcium magnesium silicate compound". The silicate may or may not be the same as the compound. And unless the claim indicates that they are, there is no antecedent basis for the "the calcium magnesium silicate".

Claims 5 and 6: there is no antecedent basis for "the comparative composition". There is only basis for comparative "product". Since a product may have more than one composition, it is not understood whether the claim requires the product be of a single uniform composition.

Claim 7 is not understood as to the composition having less magnesium oxide than what. Claim 1 does not require any magnesium oxide be used. Only a magnesium oxide "compound" and a silicate compound. IT is unclear if claim 7 requires that claim 1 also has to have magnesium oxide as a starting material.

Claim 7: there is no antecedent basis for "the batch-free time".

Claim 8: there is no antecedent basis for "the temperature for refining". Most refining operations do not have a single temperature, it is unclear which temperature the claim is referring to.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mirkovich "Utilization of Dioxide in the Manufacture of Glass" Canadian Mines Branc Tech Bulletin, 1974.

Mirkovich discloses creation of a glass product which has boron oxide (2nd paragraph, page 5) plus other glass components such as Potassium oxide and sodium oxide. The summary discloses the use of a silicate compound which meet the present formula.

Mirkovich does not disclose the admixing and melting refining and forming. It would have been obvious to form the glass into fibers, because that is how fibers are created. It is deemed that the mixing is a refining because it make the glass more homogenous. The claims do not indicate the degree of refining. As to the optional

second amount: since it is optional, it doesn't matter whether Mirkovich has it. However it is clear that since Mirkovich indicates that the magnesium is the limiting component, there is no additional magnesium oxide added.

Claim 4 requires that the product has an equivalent surface property to a comparative glass product. Assuming the Mirkovich fiber has a circular cross section, the equivalent surface property is "curvature" or radius. If the fiber is of another shape, then whatever term is used to describe the surface would be the equivalent surface property. It is noted that the claim does not require the existence or creation of "comparative glass product" it is merely a hypothetical glass product. Thus one could hypothesize of a fiber which has an equivalent surface property.

Claim 5: the batch-free time depends on temperature and other considerations. It is clear that one could increase the time for a hypothetical composition, by using lower processing temperatures.

Claim 6. There is no mention of "the comparative composition". The composition of the glass is not as relevant as the starting material. Clearly, if one was to use 100 kilogram chunks of starting material for the non-existent hypothetical composition, one would have to have a much higher temperature to get the glass to be refined and batch free.

Claims 7-8: it is unclear which time the claim refers to and what the equivalent composition is equivalent to. It is deemed that it is reasonable that the claim 7 composition can be equivalent to that of the comparative glass product of claim 4. It is

clear that when speaking of two non-existent hypothetical compositions, one can choose the operating parameters so that the processing time limitations are met.

Claim 9: it is inherent that that the Mirkovich fibers are continuous for their length.

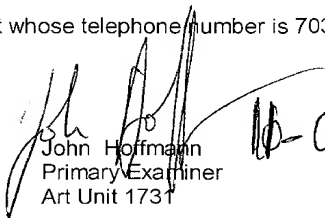
Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is 703-308-0469. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 703-308-1164. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


John Hoffmann
Primary Examiner
Art Unit 1731
10-05-03

jmh